

09/669,779

Patent Docket P1778R1

REMARKS

At the time of the 6/10/05 Office Action, claims 1-2, 5-6, 9-10, 13-19 and 25-29 were pending in the instant application. Upon entry of Applicants' amendments to claims 1-2, 6, 25 and 28-29 herein, the instant application will continue to have pending claims 1-2, 5-6, 9-10, 13-19 and 25-29. The amendments are fully supported in the specification and do not introduce new matter.

In claim 1, the definitions of A and Y have been amended.

In claim 2, the definition of Y has been amended.

In claim 6, the dependency has been amended.

In claim 25, improper punctuation has been removed.

In claims 28 and 29, proper punctuation has been incorporated.

Restriction/Election Requirement

In response to a Restriction Requirement Applicants elected without traverse the invention of group I and the single species compound no. 023 found on page 35 of the specification. The Examiner has pointed out that the elected species does not fall within the scope of claim 1 in that radical Y does not include the OH group found in compound 023. Applicants have amended claims 1 and 2 to include OH in the definition of Y. Support for the amendment can be found throughout the application and in particular on page 19, line 1. Further support can be found in the tables of compounds, many of which incorporate OH at this position.

The Examiner has objected to claim 6 as being drawn to a non-elected invention. Applicants elected group I invention drawn to compounds of formula I. Claim 6 defines radical X₁ and depends from claim 2 and is drawn to the markush structure incorporating X₁. Applicants believe claim 6 is properly directed to the elected invention and respectfully request further explanation of the objection.

Improper Markush Group Objection

The claims have been objected to as allegedly drawn to an improper Markush group. Applicants respectfully traverse. A claim should not be rejected as claiming an "improper" Markush group unless the examiner can show that the subject matter of the claim lacks unity of invention. The instant claims are drawn to compounds of formula I which incorporates a substantial core structure, a tyrosine derivative linked to a substituted phenyl group. The core structure is essential to the utility common to the claimed

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compounds, that utility being inhibition of α_4 integrins interacting with their ligands, such as MAdCAM and/or VCAM. The Examiner has provided no technical basis disputing this. Compounds included within the Markush group defined by formula I therefore: (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility.

The Examiner alleges that X_1 and A are improper Markush groups. However, where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression. MPEP 2173.05(h). As previously stated, the compounds share a substantial core structure, a tyrosine derivative in which X_1 modifies the tyrosine hydroxyl group, linked to a substituted phenyl group represented by A.

It is noted that grandparent application 09/669,779 was found to be drawn to proper Markush groups and was issued as US 6,469,047. The '047 parent claims compounds of formula III which differ from the presently claimed compounds of formula I merely by an ethylene moiety which constrains the tyrosine of the core structure. Groups X_1 and A are common to both formula III and formula I.

Rejection Under 35 USC 112

The radicals found in claims 1 and 2 are considered difficult to read by the Examiner. Accordingly, Applicants herein have increased the font size of atoms and radicals found in structures in claims 1 and 2 so that they are more legible.

Claims 27 and 28 were found to improperly depend from claim 1 in that the OH group in the definition of Y for claims 27 and 28 is not found in claim 1. As stated previously, claims 1 and 2 have been amended such that Y includes OH. Support for the amendment is found throughout the application and in particular on page 19, line 1.

Claims 28 and 29 were found to be missing a period at the end each. Applicants herein have made appropriate amendments to these claims.

Rejection Under 35 USC 102

Claims 1, 13, 14, 18 and 19 stand rejected as being anticipated by Athena Neurosciences, Inc. (reference N). Applicants respectfully traverse. The cited reference is PCT publication WO 99/06,435 having a publication date of 11 February 1999 whereas the instant application claims priority to provisional

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application 60/156,062 filed on 24 September 1999. Since the cited reference was not published more than one year prior to the effective date of the application the rejection is in error.

Claims 5, 9, 10, 15-17, 25 and 26 are objected to for being dependent upon a rejected claim. Applicants are believed to have overcome the rejections to the base claims thereby obviating the objection.

In view of Applicants' amendments and remarks presented above, the claims are believed to be in condition for allowance and early notice thereof is respectfully requested.

Respectfully submitted,
GENENTECH, INC.

Date: December 12, 2005

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*A document pursuant to 37 CFR §11.9(b) is on file in the Office of Enrollment and Discipline as proof of the authorization of the above to prosecute this application.